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EXAMINER

KOLLIAS, ALEXANDER C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 11/24/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 11/24/2008. In particular, claims 30-32 have been added reciting limitations not previously presented. Thus, the following action is properly made final.
4. Applicant is reminded of proper format of amendments to claims, which when filed on or after July 30, 2003 must comply with 37 CFR 1.121(c). Specifically, new claims 30 and 31 need not have the text of the claims underlined.
5. The terminal disclaimer filed on 11/24/2008 disclaiming the terminal portion of any patent granted on this application 11/112,778 which would extend beyond the expiration date of co-pending application 11/112,778 has been reviewed and is accepted. Therefore, the terminal disclaimer filed on 11/24/2008 overcomes the obviousness type double patenting rejections as set forth in Paragraphs 10-11 of the previous Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Claim 31 recites “at least one biocide composition said biocide composition consisting essentially of one ore more biocides.” Although Page 2, Lines 32-39 and Page 3, Lines 1-20 disclose that the composition comprises biocides, the Specification does not disclose a “biocide composition” or “one or more biocides”. Therefore there is no support in the Specification for the limitations recited in claim 31.

9. Claim 32 recites “hydrophobing agents”. Page 10, Lines 4-9 of the Specification recite that “[t]he hydrophobicizing agents from the groups consisting of fatty acid and fatty acid derivative, and organosilicon compounds”. Thus, the limitation recited in the claim drawn to a generic “hydrophobing agent” is broader than the specific “hydrophobicizing agents” disclosed in the Specification.

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10. Regarding the following amounts recited in claim 32 based on the **total weight of the redispersible polymer composition**:

- a. protective colloid(s) from 3 to 30 wt %
- b. Up to 1.5 wt % antifoam(s)
- c. Up to 30 wt % antiblock agent(s)
- d. 0.5 to 10 wt % emulsifier(s)

11. However, the Specification discloses that protective colloids are added in the amount of 3 to 30 wt % based on the portion of the polymer (Page 9, Lines 17-20), up to 1.5 wt % of antifoam based on the base [amount] polymer (Page 9, Lines 29-30), up to 30 wt % of antiblocking agents, based on the total weight of the polymeric constituents (Page 9, Lines 35-37), and 0.5 to 10 wt % of emulsifiers based on the amount of monomers (Page 8, Lines 12-13). As such there is no disclosure in the Specification of the recited of ingredients (a) -(d) based on the **total weight of the redispersible powder composition** as presently claimed.

Furthermore claim 32 recites that the amounts of the ingredients “total to 100 %”. However, there is no disclosure, except for amount of the hydrophobing agents, biocides, protective colloids, emulsifiers, anti-blocking agents, and antifoams as previously discussed. Therefore the limitation drawn to a total of 100 % is not supported by the Specification.

Claim Rejections - 35 USC § 102

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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13. Claims 11-22, 24-25, and 27-31, are rejected under 35 U.S.C. 102(b) as being anticipated by Weitzel et al (US 2003/0018121).

The rejection is adequately set forth in paragraph 4 of Office action mailed on 9/9/2008 and is incorporated here by reference.

Regarding, claim 26, Weitzel teaches all the claim limitations as set forth above. Regarding the newly recited limitations, that "the water-redispersible polymer powder composition is obtained by mixing the biocide into the aqueous polymer dispersion prior to drying or adding the biocide in solid form after drying the aqueous polymer dispersion". The reference discloses that the biocides which can be dried by under reduced vapor pressure and added to the polymer which is the form of a dispersion or powder, i.e., dried (Page 4, [0036] and [0038]).

Regarding claims 30-31, in setting forth the rejection these claims, the Examiner notes that since these claims are drafted in Jepson format where the preamble is admitted prior art (whether to applicant or to another), hence, absent contrary evidence, it is the non-preambular part of the claims that is to be analyzed for patentability over prior art.

Regarding claims 30-31, Weitzel et al discloses a polymer powder comprising film forming redispersible polymer powder and a biocide (Abstract, Page 1 [0009], Page 2 [0015]-[0018], Page 3 [0023], Page 4 0038)).

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Although Weitzel does not disclose spray drying a biocide containing aqueous dispersion, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Weitzel meets the requirements of the claimed composition, Weitzel clearly meets the requirements of present claims.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 23, 26, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (US 2003/0018121).

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The rejection of claim 23 is adequately set forth in paragraph 8 of Office action mailed on 9/9/2008 and is incorporated here by reference. The discussion with respect to Weitzel as set forth in Paragraph 11 above is incorporated here by reference.

Regarding claim 26, Weitzel et al teaches all the claim limitations as set forth above. Additionally, the reference discloses that the dried polymer is the form of a powder and may be mixed with other formulation ingredients without adding solvents (Page 4, [0038]). Furthermore, it is noted that the reference discloses that the biocidal compound is complexed with cyclodextrin (Page 4, [0024]). The reference discloses that the cyclodextrin comprising biocidal compound may be dried and solvent may be removed by drying, thereby producing a solid complex (Page 4, [0036]).

Given that the reference discloses a process of producing a coating composition is mixed in the form of a powder with other formulation ingredients, including complexed biocides, it would have been obvious to one of ordinary skill in the art to mix the dried biocidal complex and polymer in order to obtain a dry mix coating composition.

Regarding claim 32, Weitzel et al teaches all the claim limitations as set forth above. Additionally, the reference discloses that the aqueous dispersion comprises 50 to 60 % solid contents wherein 3 to 30 wt % protective colloids (based on total dispersed polymer) , up to 1.5 % anti-foam agents based on the base polymer, up to 40 wt % anti-blocking agents, based on the overall weight of the polymeric constituents, 0.001 to 0.2 wt % biocides, pigments, and fillers based on the overall weight of the composition (Page 3, [0023]-[0025] and [0028]-[0030]).

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Based on the amount of solids contents in the aqueous dispersion and utilized the amounts of biocide, filler, and pigment on a gram basis, it is determined that the film polymer comprising 87 to 28.3 wt %, biocides, comprise 0.0017 to 0.09 wt %, 0 to 0.4 wt % anti-foam agents, 0 to 11.0 anti-blocking agents, and 2.6 to 8.4 wt % protective colloids.

Regarding the amount of protective colloid disclosed by the reference, it is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir. 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Double Patenting: I

17. Claims 11-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 13, 17-21, and 25 of copending Application No. 11/720,091 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 12-13 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: II

18. Claims 11-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 2, and 10 of U.S. Patent No. 5,753,733 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 14-16 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: III

19. Claims 19-24 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,191,235 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 17-19 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: IV

20. Claims 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 5 of U.S. Patent No. 6,429,239 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 20-22 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: V

21. Claims 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 1, 2, and 5 of U.S. Patent No. 6,660,079 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraph 23-24 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: VI

22. Claims 11-13 and 16-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 5, 11-12, 15, and 17 of U.S. Patent No. 6,740,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 25-26 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Double Patenting: VII

23. Claims 11-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 5-10,12-13, 15, and 17-23, 11-12 of U.S. Patent No. 7,183,358 in view of Weitzel et al (US 2003/0018121).

The obviousness-type double patenting rejection is adequately set forth in Paragraphs 27-28 of the Office Action mailed on 9/9/2008 and is incorporated here by reference.

Response to Arguments

24. Applicant's arguments filed 11/24/2008 have been fully considered but they are not persuasive.

25. Applicant argues that Weitzel discloses a biocide cyclodextrin complex and that this complex is not the same as an uncomplexed biocide. However, it is noted that claim 11 generically recites biocide and not specify that biocide is complexed or not. Furthermore, it is the Examiner's position that the complexed biocide disclosed by Weitzel is still a biocide and the disclosure of which still reads on the claims of a biocide. Although the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., uncomplexed biocidal compounds) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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26. Applicant argues unexpected results regarding polymer powders comprising uncomplexed biocide as compared to compositions comprising uncomplexed biocides (Page 10, Paragraphs 2-4 of Remarks) However, with respect to the anticipation rejection of the claims using Weitzel, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

27. Regarding Applicant's arguments that Weitzel does not disclose hydraulically settable mineral binder. Examiner points to Page 4 Paragraph [0032] where the reference discloses inorganic binder such as cement which by Applicant's own admission on is a hydraulically setting binder, as evidenced on Page 10, Lines 21-24 of the instant Specification. Furthermore, it is noted and as set forth in the previous office Action that the binders disclosed by the reference are optional and not required, hence meeting the limitations recited in claims 14-15, 27, and 29.

28. Regarding Applicant's arguments regarding the addition to the biocide to the dispersible polymer dispersion prior to spray drying, given that the disclosure in Paragraph [0023] and [0030] of Weitzel, it is clear that the biocide can be added to the polymer dispersion followed by spray drying. Further, it is noted that even the reference did not teach this process and claims 12 and 13 recite a produce, hence the process limitations recited in claimed are drawn to a product by process. Therefore, it is noted that "[E]ven though product-by-process claims are limited by

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and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Weitzel meets the requirements of the claimed composition, Weitzel clearly meets the requirements of present claims.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)-270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796